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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/933,285	Applicant(s) SMITH ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 2-4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how the step of "appointing a process champion" would further limit the step of "collecting ideas".

Furthermore, the phrase "process champion" is vague and indefinite because it's not clear how what does this mean even to a person of ordinary skill. Why is a "champion" or a "winner" or "a valiant fighter" is needed to plainly collect ideas?

2. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how the step of "convening a meeting of the management screening committee" further limits the step (b) of "entering the collected ideas into an electronic archive".

3. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how the step (d) of "providing the ideas to a management ... committee" or "sending the ideas to the committee" is further limited by "including performing exploratory research and

development"? Maybe, providing a "report of the ideas" to a management and wherein the report including performing exploratory research and development is a better phrase.

4. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s). Claim 10 supposedly further limits a "phase" or "stage" (noun) or "the opportunity screening phase". Generally, limiting a "noun" would require an adjective, i.e. temporary or transient or urgent. It's not clear how a series of steps further limit a noun or phase. It appears that claim 10 further limits step (f) and not the "phase" alone.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

2. As an initial matter, the United States Constitution under Art. 1, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

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promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

3. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions (3) include (1) "laws of nature", (2) "natural phenomena", and (3) "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149, F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

4. Mere idea in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

5. This "two-prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences

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(BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the *Freeman-Walter-Abele* test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175, USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

6. The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter is statutory, not on whether the product of the claimed subject matter is statutory, not on whether the prior art which the claimed subject matter purports to replace is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., but whether it "enhances" the operation of a machine. In *re Toma* at 857.

7. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the *Freeman-Walter-Abele* test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful,

concrete and tangible result". See *State Street Bank & Trust Co. at 1374*. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "whether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co. at 1377*. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

9. Thus the present basis for a 35 USC 101 inquiry is a 2-prong test:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

10. Claims 1-10, 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. As to the 2nd-prong test, for a claimed invention to be statutory, the

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claimed invention must produce a useful, concrete, and tangible result. In the present case, as to claim 26, the claimed invention appears to produce a result "placing the ingredients and their calculated quantities on a delivery list" which is accepted (i.e., useful, concrete and tangible).

12. As to the 1st-prong test, independent claim 26, and its dependent claims, 1-10, 11, fail this test. Under this test, for a process claim to pass muster under the "technological arts" prong, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 26-29 have no connection to the technological arts. The recited steps of merely "(a) collecting ideas, b) entering the collected ideas ..., and f) entering into an opportunity screening phase", does not apply, involve, use, or advance the technological arts in a non-trivial way since all of the recited steps can be performed in the mind of a person, by use of a pencil and paper, then manually and physically presenting to another person. As for step (b), through a network, this is not sufficient to overcome this rejection since it is only a trivial use of technology, such as sending a request by e-mail, while all the other steps as mentioned above may be mental or manual only.

13. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts in a non-trivial way as explained above, claims 1-10, 11 are deemed to be directed to non-statutory subject matter.

14. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological

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arts, such as incorporating a computer network or electronic network into some of the steps; for example: "(a) collecting ideas over the computer network ...; c) displaying ... using the computer network, and f) Using the computer network. The other claims could be similarly amended to include a computer network or a computer, in a significant way, in at least some of the steps.

15. See also (1) In re Schrader, 22 F.3d 290, 30 USPQ2d 1455 (CCPA 1994), (2) In re Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557, (3) In re Waldbaum, 173 USPQ 430 (CCPA 1972), (4) In re Musgrave, 167 USPQ 280 (CCPA 1970), and (5) In re Johnston, 183 USPQ 172.

Claim Rejections - 35 USC § 112

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 1, recites the limitation "the submission" in step (c). There is insufficient antecedent basis for this limitation in the claim.

2) In claim 1, it's not clear the relationship step (c), "members of the organization" to the subsequent steps (d), (e), and (f).

3) In claim 1, step (f) is not clear. What is entering?

4) Claim 3, recites the limitation "idea submissions" in line 2. There is insufficient antecedent basis for this limitation in the claim.

5) Claim 4, recites the limitation "idea submission volume" in line 2. There is insufficient antecedent basis for this limitation in the claim.

6) Claim 6, recites the limitation "the system" in line 1. There is insufficient antecedent basis for this limitation in the claim.

7) In claim 7, which refers back to step (b) of claim 1, it's not clear whether the phrase "entering ideas" refers back to the "collected ideas" or this is a new set of ideas?

8) Claim 8, recites the limitation "submitted ideas" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-10 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GAKIDIS et al (US 2002/0095305).

As for independent method¹ claim 1, GAKIDIS et al discloses a method and system for managing the submission of ideas in an organization, comprising the following steps:

- (a) collecting the ideas (information/data) {see [0001, 0048], [0026], Fig.1};
- (b) entering the data into an electronic archive (database) accessible through a network {see [0048, 0026], Fig. 1};
- (c) displaying the ideas to members of organization so that the members of the organization can provide additional thoughts to the submission {see [0019, 0058, 0072, 0026]};
- (d) providing the ideas to a management screening committee for screening {see 0019, 0024, 0026}},
- (e) submitting ideas screening by the management screening committee to an idea sponsor {[0058, 0048, 0056]}; and
- (f) entering into an opportunity screening phase {[0058, 0059, 0021]}.

Alternatively, the selection of the screened ideas for any other potential opportunity, i.e. investment, funding, etc. would have been obvious as mere selection of other similar opportunities to achieve similar results.

As for dep. claim 2 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. selection someone, group, committee or department to collect submitted ideas, this is taught in [0005, 0010 or 0011]. As for the name of the committee, the selection of any name is a matter of choice and would have been obvious to a skilled artisan as mere non-essential modifications within the scope of the claim as discussed by GAKIDIS et al on [0119].

As for dep. claim 3 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. using e-mail for communication on the Internet/web, this is well known and inherently included in GAKIDIS et al. Alternatively, it would have been obvious to a skilled artisan to communicate using e-mail since this is well known communication mean on the Internet/Web.

As for dep. claim 4 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. convening a meeting when the submission volume reaches a certain level, this is inherently included in the teachings of GAKIDIS et al or would have been obvious to a skilled artisan as mere routine experimentations in view of the teachings on [0119].

As for dep. claims 5-6 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. including exploratory and development of ideas, this is taught in [0003-0008].

As for dep. claim 7 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. entering ideas into a web-based archive interface, this is taught in Fig. 1, [0072, 0072].

As for dep. claim 8 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. displaying the ideas on the website to other viewers, including submitter, this is inherently included in Fig. 1, [0020] of GAKIDIS et al.

As for dep. claim 9 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. the type or features of the reviewers, experienced reviewers, this is taught in [0010 "senior managers", 0019 "Experts", 0049].

As for dep. claim 10 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. general evaluation/feedback communication, this is taught in [0054, 0055, 0058, Fig. 2].

10. Claims 12-14, and 11 are rejected under 35 U.S.C. 103(a) as obvious over GAKIDIS et al (US 2002/0095305).

As for independent apparatus¹ claim 12, which is the apparatus to carry out the method of claim 1 above, it's rejected over the computer network system of GAKIDIS et al to carry out the method of claim 1 above. As for the limitation of the archive being searchable by keyword, Official notice is taken that search service by keyword, after e-mail, are frequent used tools on the Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost. It would have been obvious to a skilled artisan to include search service by key

word for the benefit cited above which is Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost.

Note that in claim 12, the 2nd element, which calls for each personnel computer in the network "being capable of displaying a display screen", the limitation "being capable" or has the capacity, is not positively claimed since no step has been carried out using the capacity, thus has no patentable weight. In other word, the personal computer of GAKIDIS et al, as shown on Fig. 1, (108) has that capacity or capable of doing that.

As for dep. claims 13-14, which further modify the display screen, these claims have no patentable weight since depending on a no-patentable weight limitation. In other word, the computer system of GAKIDIS et al are capable of having these features of these claims.

As for independent mehod² claim 11, which has nearly the same scope and steps as in claims 1, 2, 3, and 10, it's rejected for the same reasons set forth in claims 1, 2, 3, and 10 above. Moreover, language such as "if found" on (e), and "I" and "j", are considered as optional, thus carrying no patentable weight. The examiner, is taken the position of "if not found" or "if not", which would limit the claim to steps (a) – (d). Moreover, these limitations are fairly taught in GAKIDIS as indicated above.

11. Claims 12-14 are rejected (2nd) under 35 U.S.C. 103(a) as obvious over GAKIDIS et al (US 2002/0095305) in view of DAVIS et al (US 2001/0047354) or PETRAS et al (US 2001/0047290).

As for independent apparatus¹ claim 12, the teachings of GAKIDIS et al is cited above.

DAVIS et al is cited to teach that search service by key word, after e-mail, are frequent used tools on the Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost {see [0008, 0009, 0010]}. It would have been obvious to a skilled artisan to modify GAKIDIS et al by including search service by key word as taught by DAVIS et al for the benefit cited above which is Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost.

PETRAS et al al is cited to teach that search service by key word, after e-mail, are frequent used tools on the Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost {see [0038, Figs. 15, 20]}. It would have been obvious to a skilled artisan to modify GAKIDIS et al by including search service by key word as taught by PETRAS et al for the benefit cited above which is Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost.

Note that in claim 12, the 2nd element, which calls for each personnel computer in the network "being capable of displaying a display screen", the limitation "being capable" or has the capacity, is not positively claimed since no step has been carried out using the capacity, thus has no patentable weight. In other word, the personal computer of GAKIDIS et al, as shown on Fig. 1, (108) has that capacity or capable of doing that.

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As for dep. claims 13-14, which further modify the display screen, these claims have no patentable weight since depending on a no-patentable weight limitation. In other word, the computer system of GAKIDIS et al are capable of having these features of these claims.

No claims are allowed.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
September 26, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER